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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,007	02/06/2004	Scott S. Isola	M24-108	5360

7590 06/26/2006

R. Neil Sudol
714 Colorado Avenue
Bridgeport, CT 06605-1601

EXAMINER	
PEFFLEY, MICHAEL F	

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/773,007	ISOLA ET AL.	
	Examiner	Art Unit	
	Michael Peffley	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *34-37* is/are allowed.

6)☒ Claim(s) *1,12-16 and 31* is/are rejected.

7)☒ Claim(s) *2-11,17-30,32 and 33* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 February 2004* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/17/04; 10/24/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the originally filed drawings are deemed to be informal. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 12-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (6,056,735) in view of the teaching of Wilk et al (5,383,883).

Okada et al disclose a surgical device comprising a forceps member having at least one prong (1) and a mechanical connector (i.e. proximal handle) for removably fastening the forceps member to a housing (4) of an ultrasonic probe (7). Okada et al fail to teach providing an electrode and electrical connection means connected to the forceps prong.

Wilk et al teach that it is generally known to provide an ultrasonic forceps device with an electrical connection to the jaw assembly to allow for the treatment of tissue with both RF and ultrasonic energy.

To have provided the Okada et al device with an RF electrode on the forceps prong to allow for the treatment of tissue with both RF and ultrasonic energy would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Wilk et al.

Claims 15 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al ('735) and Wilk et al ('883) as applied to the claims above, and further in view of Williamson et al (6,024,741).

Neither Okada et al nor Wilk et al expressly teach that the prong member(s) is made from an insulative material with an electrode thereon. The examiner maintains that it is generally well known to make RF forceps devices with insulative jaw members having electrodes located thereon. Williamson et al is one such teaching of a forceps-type device that has jaws made from an insulative substrate with the electrodes provided at selected areas on the jaw member to provide a desired treatment pattern to tissue.

To have provided the Okada et al device, as modified by the teaching of Wilk et al, with an insulative jaw member having the electrode mounted on the insulative substrate would have been an obvious design consideration for one of ordinary skill in the art, particularly in view of the Williamson et al teaching.

Allowable Subject Matter

Claims 2-11, 17-30, 32 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to disclose the particular connection arrangement between the forceps device and the ultrasonic probe as set forth in these claims.

Claims 34-37 are allowed. The prior art fails to disclose the particular method steps of attaching a forceps device to an ultrasonic probe casing and, in particular, detaching the forceps member from the casing after treating tissue. It is noted that prior art references such as Okada et al ('735) disclose a forceps device attached to an ultrasonic probe casing as asserted in the rejection. However, there is no suggestion of detaching the forceps device after tissue treatment as set forth in method claim 34.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miyawaki et al (6,193,709) disclose another ultrasonic grasping device analogous to the Okada et al device. Mollenauer (2004/0064151) and Truckai et al (6,773,409) disclose forceps device that use ultrasonic energy to treat tissue. Brown et al (6,723,092) and Treat et al (6,860,880) disclose RF forceps devices and disclose that ultrasonic vibration may also be used to treat tissue. Manna et al (6,736,814) disclose an ultrasonic probe that is fitted with RF electrodes to treat tissue. There is no disclosure of a forceps device in the Manna et al device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Peffley
Primary Examiner
Art Unit 3739

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June 19, 2006